Supreme Court, U.S.
FILED
NOV 9 2000

(15)

No. 99-1571

IN THE

Supreme Court of the United States

TRAFFIX DEVICES, INCORPORATED,
Petitioner,

v.

MARKETING DISPLAYS, INCORPORATED,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit

REPLY BRIEF FOR PETITIONER

JEANNE-MARIE MARSHALL
RICHARD W. HOFFMANN
REISING, ETHINGTON, BARNES, KISSELLE, LEARMAN & MCCULLOCH, P.C.
201 W. Big Beaver—Suite 400
Troy, Michigan 48084
(248) 689-3500

JOHN G. ROBERTS, JR.*
H. CHRISTOPHER BARTOLOMUCCI
HOGAN & HARTSON L.L.P.
555 Thirteenth Street, N.W.
Washington, D.C. 20004
(202) 637-5810

* Counsel of Record

Counsel for Petitioner

23 pp

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
I. THIS COURT'S CASES ESTABLISH A RIGHT TO COPY FROM EXPIRED PATENTS	1
II. THE RIGHT TO COPY EXTENDS TO THAT WHICH ENJOYED PROTECTION UNDER THE PATENT	7
III. RESPONDENT'S "LEGAL FUNCTIONALITY" TEST WOULD ALL BUT ELIMINATE THE RIGHT TO COPY	11
IV. THERE IS NO BASIS IN THE LANHAM ACT TO SUBORDINATE THE RIGHT TO COPY TO "LEGAL FUNCTIONALITY"	14
V. MDI'S PARADE OF HORRIBLES IS NOT SO FRIGHTENING	16
CONCLUSION	19

TABLE OF AUTHORITIES

	Page
Cases:	
Bonito Boats, Inc. v. *Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989)	*passim*
Compco Corp. v. *Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964)	3, 4
G. & C. Merriam Co. v. *Syndicate Publ'g Co.*, 237 U.S. 618 (1915)	7
Graham v. *John Deere Co.*, 383 U.S. 1 (1966)	10
Kellogg Co. v. *National Biscuit Co.*, 305 U.S. 111 (1938)	3, 9
Midwest Indus. Inc. v. *Karavan Trailers, Inc.*, 175 F.3d 1356 (Fed. Cir.), *cert. denied*, 120 S. Ct. 527 (1999)	3
Qualitex Co. v. *Jacobson Prods. Co.*, 514 U.S. 159 (1995)	11, 12, 13
Sarkisian v. *Winn-Proof Corp.*, 697 F.2d 1313 (9th Cir.), *cert. denied*, 460 U.S. 1052 (1983)	7
Scott Paper Co. v. *Marcalus Mfg. Co.*, 326 U.S. 249 (1945)	2, 5
Sears, Roebuck & Co. v. *Stiffel Co.*, 376 U.S. 225 (1964)	1, 3, 4, 9
Singer Mfg. Co. v. *June Mfg. Co.*, 163 U.S. 169 (1896)	1, 3, 7, 9
United States v. *American Bell Tel. Co.*, 167 U.S. 224 (1897)	7
Zip Dee, Inc. v. *Dometic Corp.*, 931 F. Supp. 602 (N.D. Ill. 1996)	5

TABLE OF AUTHORITIES—Continued

	Page
Constitution:	
U.S. Const. art. I, § 8, cl. 8	2
Other:	
J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th ed. 1996)	11

IN THE

Supreme Court of the United States

No. 99-1571

TRAFFIX DEVICES, INCORPORATED,
Petitioner,

v.

MARKETING DISPLAYS, INCORPORATED,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit

REPLY BRIEF FOR PETITIONER

I. THIS COURT'S CASES ESTABLISH A RIGHT TO COPY FROM EXPIRED PATENTS.

1. We explained in our opening brief that this Court has long recognized a public right to copy and use the subject of expired patents. Pet. Br. 17-21. That right was articulated in cases such as *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U.S. 169, 185 (1896) ("on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property") and *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 225, 230 (1964) ("when the patent expires the monopoly created by it expires, too, and the right to make the article * * * passes to the public"), and was reaffirmed by a unanimous Court in *Bonito Boats, Inc.* v. *Thunder Craft Boats, Inc.*, 489 U.S. 141, 165 (1989) (emphasis in original): "For almost 100

years it has been established that in the case of an expired patent, the federal patent laws *do* create a federal right to 'copy and use.' "

We also explained that this right to copy is an essential aspect of the "patent bargain" underlying our patent system—it is the consideration the public receives in exchange for granting an inventor the exclusive right to his invention for a period of years. Pet. Br. 12-17. As this Court has noted, the patent monopoly is granted "on the condition that [the inventor] make full disclosure for the benefit of the public of the manner of making and using the invention, and that upon the expiration of the patent the public be left free to use the invention." *Scott Paper Co.* v. *Marcalus Mfg. Co.*, 326 U.S. 249, 255 (1945). That bargain not only faithfully reflects the history and policy of the Patent Clause, *see* Pet. Br. 12-15, but also gives effect to the constitutional command that patents be granted only "for limited Times." U.S. Const. art. I, § 8, cl. 8.[1]

2. In response, MDI contends that "[t]here is no Constitutional, statutory, or overriding policy requirement that *per se* forecloses federal trade dress protection for subject matter disclosed or claimed in an expired patent." Resp. Br. 1. Its amici sing the same tune. *See* Thomas & Betts Br. 5

[1] MDI seeks to distinguish the cases on which we rely on the ground that they considered the right to copy in juxtaposition with state unfair competition law, not federal trademark law. Resp. Br. 29-30. We have already explained that this distinction is unavailing. Pet. Br. 36; *see also* SG Br. 18-19. The patent bargain is compromised when the public is denied its reciprocal right to copy from expired patents, whether that result is achieved under state or federal law. There is no indication that Congress intended to extend trade dress protection in such a way as to undermine the right to copy from expired patents, and every reason to believe that it instead intended to codify the *Singer* line of cases that was an entrenched part of the law of unfair competition when the Lanham Act was enacted. *See* Pet. Br. 28-37; SG Br. 14-15, 17.

(referring to "the *purported* 'right to copy' ") (emphasis added); AIPLA Br. 6 ("the public's 'right' to copy"); *see also* Opp. 5 ("so-called 'right to copy' "). MDI chides us for relying on "older Supreme Court opinions," Resp. Br. 7, and relies instead on lower court decisions for the proposition that "there is 'no provision of patent law, statutory or otherwise, that guarantees to anyone an absolute right to copy the subject matter of an expired patent.' " *Id.* 27 (quoting *Midwest Indus., Inc.* v. *Karavan Trailers, Inc.*, 175 F.3d 1356, 1362 (Fed. Cir.), *cert. denied*, 120 S. Ct. 527 (1999)).

We agree that the right to copy is not "absolute," and have never argued the contrary. As MDI points out, the Court in *Singer* required the copier to affix "a plain and unequivocal indication of the origin of manufacture" on its copies to prevent consumer confusion, 163 U.S. at 204, the Court in *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111, 120 (1938), noted that the newcomer was obliged through packaging "to identify its product lest it be mistaken for that of the plaintiff," and the Court in *Sears* recognized that States may require that goods "be labeled or that other precautionary steps be taken to prevent customers from being misled as to the source." 376 U.S. at 232. We made the same point in our opening brief. *See* Pet. Br. 34-35. But it is one thing to require labeling, distinctive packaging, or the like to avoid consumer confusion between the original and a copy, and quite another to preclude copying the subject of an expired patent altogether under the guise of avoiding such confusion. That would be a classic case of throwing the baby out with the bathwater, and nothing in this Court's cases recognizing the right to copy remotely suggests that it may be so readily and so completely compromised in the name of avoiding confusion.[2]

[2] MDI and its amici rely heavily on a negative inference drawn from dicta in *Compco Corp.* v. *Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964), in which the Court stated that the right to copy extends to products that are not "entitled to a design patent or other federal

For this reason, MDI's suggestions that the right to copy we invoke includes the right to copy trademarks, or ornamental designs having nothing to do with an invention claimed in a patent, can readily be put to one side. We agree that those exercising the right to copy must refrain from "palming off their copies as the original," *Compco*, 376 U.S. at 238, but that repeated caveat presupposes the right to copy "the article itself," *Sears*, 376 U.S. at 232-233, or "the product itself," *Bonito Boats*, 489 U.S. at 158, in the first place. As this Court explained in *Bonito Boats*, "[t]he defendant * * * may copy plaintiff's goods slavishly down to the minutest detail: but he may not represent himself as the plaintiff in their sale." *Id.* at 157 (quotation omitted). Here it is undisputed that "[t]he TrafFix Devices company name appears on each and every dual spring sign stand manufactured and distributed by TrafFix Devices, Inc." J.A. 253. To the extent TrafFix's use of the WINDBUSTER name may have caused consumer confusion, MDI was entitled to seek and has sought and secured relief barring TrafFix's use of that name. *See* Pet. App. 4a-12a. What MDI may not do is bar the copying of "the article itself." *Sears*, 376 U.S. at 232-233.

3. MDI objects that our approach allows competitors to profit off the goodwill it has acquired in the configuration of its sign stand, and indeed that TrafFix copied that configuration to "take advantage of the tremendous goodwill and

---

statutory protection." *Id.* at 238. There is nothing in the context of that statement to suggest, however, that the Court intended the phrase "other federal statutory protection" as a reference to the Lanham Act, much less that the ambiguous reference constitutes a holding that the Lanham Act overrides the patent law right to copy. To the contrary, as the Solicitor General has explained, the Court in *Compco* upheld the right to copy in the face of an argument that recognizing such a right would limit the scope of the Lanham Act. *See* SG Br. 18-19 & n.7. In such circumstances the dicta cannot be read as subordinating the right to copy to Lanham Act claims.

commercial success enjoyed by MDI's sign stand." Resp. Br. 8; *see id.* 18, 21. TrafFix copied the configuration of MDI's sign stand for the simple reason that it was a better sign stand—not because customers associated the configuration with MDI. J.A. 331. To the extent MDI was able to accumulate goodwill in the configuration of its sign stand, it was of course because the patents prevented anyone else from using that configuration for an extended period. *See, e.g., Zip Dee, Inc.* v. *Dometic Corp.*, 931 F. Supp. 602, 615 (N.D. Ill. 1996) (it is "no great trick to build up secondary meaning in a product configuration if [competitors] are kept from utilizing that configuration for 17 years by the sword and shield of patent protection").

This Court has already held that goodwill developed during the term of a patent cannot be relied upon to extend the life of the patent under the guise of trademark law:

> By the force of the patent laws not only is the invention of a patent dedicated to the public upon its expiration, but the public thereby becomes entitled to share in the good will which the patentee has built up in the patented article or product through the enjoyment of his patent monopoly. * * * [T]he patentee may not exclude the public from participating in that good will * * *. [*Scott Paper*, 326 U.S. at 256.]

That is, however, precisely what MDI seeks to do in relying on the alleged goodwill in the configuration of its sign stand to "secure * * * a continuation of [its] monopoly by resorting to the trademark law." *Id.*[3]

---

[3] MDI's claim that "TrafFix would not have been able to copy MDI's trade dress if the patents had never existed," Resp. Br. 8, misses the mark. As noted, MDI was able to acquire secondary meaning in its traffic sign stand only because competitors were prevented from copying it by the patent. If "the patents had never existed," that secondary meaning would never have developed. In addition, our position is that there is a right to copy from an

MDI's response is telling. It argues that TrafFix could have manufactured a sign stand that looked just like MDI's during the period of patent protection, but avoided patent infringement by having springs that lacked the initial compression described in the patent. Resp. Br. 19 n.15, 36 n.23. That way, MDI contends, TrafFix and other competitors could have prevented MDI from developing secondary meaning in the configuration in which it practiced its patent, thereby preventing that configuration from qualifying for trade dress protection upon the expiration of the patent. The only catch, of course, is that these hypothetical sign stands with uncompressed springs would not have worked, because—as MDI explained in its patent—initial compression of the springs is a necessary feature of the invention. *See* Resp. Br. 3; L44, L48. If the sign stands do not work, they certainly would not have been effective in defeating the development of secondary meaning in the stands that do.[4]

II. THE RIGHT TO COPY EXTENDS TO THAT WHICH ENJOYED PROTECTION UNDER THE PATENT.

1. MDI contends that it is unclear what we mean when we say the right to copy extends to that which was "covered by" or the "subject" of a patent. Resp. Br. 35. We mean the same thing this Court means, when it regularly uses the same phraseology.[5] We mean the same thing MDI did, when it repeatedly asserted in its advertisements and trade literature that its WINDMASTER sign stands, and particularly the dual-spring feature, were "covered by" the pertinent patents. *See, e.g.*, L53, L56, L60, L75, L81, L85, L88, L89. And we give the same meaning to MDI's patents that MDI did, when it sued Winn-Proof for patent infringement for producing a sign stand indistinguishable from both MDI's WINDMASTER stand and the TrafFix stand at issue in this case. *See Sarkisian* v. *Winn-Proof Corp.*, 697 F.2d 1313 (9th Cir.), *cert. denied*, 460 U.S. 1052 (1983); Pet. Br. 6, 21-23, 1a. In short, the right to copy encompasses whatever enjoyed legal protection under the patent at issue.[6]

---

expired patent, not that there is no right to copy in the absence of an expired patent. Quite apart from the existence of the patents, TrafFix would have been able to copy MDI's alleged trade dress because it is functional.

[4] MDI's response is also telling for what it reveals about the scope of a product configuration trade dress claim after expiration of a patent. MDI's trade dress claim does not depend upon whether its product incorporates all the limitations in the patent, such as the initial compression of the springs. MDI's position would thus allow patentees to obtain *broader* protection under trade dress law than they had enjoyed under patent law, and for perpetuity rather than for a limited period of years. Such a result raises serious questions under the Patent Clause.

[5] *See, e.g.*, *Bonito Boats*, 489 U.S. at 152 ("after the expiration of a federal patent, the subject matter of the patent passes to the free use of the public"); *G. & C. Merriam Co.* v. *Syndicate Publ'g Co.*, 237 U.S. 618, 623 (1915) ("on the expiration of a patent there passe[s] to the public * * * the right to make the machine in the form covered by" the patent); *United States* v. *American Bell Tel. Co.*, 167 U.S. 224, 249 (1897) ("when a patent expires the invention covered by that patent shall be free to every one"); *Singer*, 163 U.S. at 185 (when a patent expires, "the right to make the thing formerly covered by the patent becomes public property" and the public acquires "the device covered by the patent").

[6] MDI argues that the "traffic-type" sign stands at issue in this case are different from the "business-type" stand depicted in its patents. *See* Resp. Br. 2, 3, 4. But MDI has always argued that the narrowly-spaced apart dual coil springs of its traffic sign stands are covered by the patents to the same extent as the further-spaced apart dual coil springs of its business sign stands. In the *Winn-Proof* litigation MDI argued that Winn-Proof's sign stands with narrowly-spaced coils "were slavish copies, from the standpoint of function, of the sign stand described and claimed in the Sarkisian patents." J.A. 236. *See also* J.A. 201 (arguing that "spaced-apart" limitation in patent claims was added to distinguish "concentrically mounted springs" and that "[t]he location and position of the coil springs on the accused [Winn-Proof] devices is in full accordance

Our approach, and that of the Solicitor General, implements the right to copy from an expired patent by focusing on what was covered by the patent. Simply put, if the asserted trade dress was entitled to patent protection during the term of the patent, it does not qualify for trade dress protection when the patent expires. The scope of the right to copy and the patent right to exclude are the same.

2. Discerning what features are protected by a patent is not a new burden or responsibility—manufacturers routinely confront that question in deciding whether to enter a particular market. The patent system is designed to facilitate a clear answer. *See Bonito Boats*, 489 U.S. at 162 (patent system "provides a ready means of discerning the status of the intellectual property embodied in an article of manufacture or design"). In the *Winn-Proof* litigation, MDI specifically argued that its patents provided just this sort of notice. *See* J.A. 207-208, 226-227.

MDI claimed in its patents that its invention was a sign stand with "two spaced apart spring connections" which performed the function of permitting the sign to yield to the wind without twisting. Pet. App. 18a, 50a. MDI's trade literature focused on the "[p]atented dual-spring mount design" as it appears on the WINDMASTER traffic sign stands. L88. *See also* L89. That is the same feature it now

---

with the meaning and scope of the term 'spaced-apart' in the Sarkisian patents"); 237. MDI's promotional materials depict the narrowly-spaced apart dual coil springs of the traffic sign stand and describe that feature as the "[p]atented dual-spring mount design" and the "patented spring-mount WindMaster design." L88, L89. *See also, e.g.*, L53, L56, L60, L75, L81, L85 (MDI assertions that its traffic stands with narrowly-spaced apart springs are "covered by" the patents at issue). It is far too late in the day for MDI to attempt to change its tune and suggest that the dual spring feature of its traffic sign stand is not claimed in its patents, and in fact MDI stops short of such an assertion. *See* Pet. Br. 5-6, 22-23; SG Br. 27-28 n.15.

seeks to protect as trade dress; the "two spaced apart spring connections" is the only aspect of its asserted trade dress claim that differs from its competitors' stands. Pet. App. 48a, 60a ("MDI's own references to its product effectively concede the fact that the dual spring configuration is the only element that sets MDI's alleged trade dress apart from that of its competitors."). Because that feature was covered by MDI's patents—a point MDI confirmed in its advertising and when it successfully prosecuted Winn-Proof for making a sign stand just like the TrafFix stand at issue here—the feature may not be protected as trade dress once the protection it enjoyed under the patent has expired.

This is a clear case, not only because the *Winn-Proof* litigation confirms that what MDI now seeks to protect under the guise of trade dress is precisely what it previously protected under its patents, but also because the form MDI seeks to protect as trade dress is precisely the form in which it practiced its claimed invention during the life of the patent. This Court has repeatedly recognized that the right to copy from an expired patent includes "the right to make [the article] in the form in which it was constructed during the patent." *Singer*, 163 U.S. at 185. *See also Kellogg*, 305 U.S. at 122 (same); *Sears*, 376 U.S. at 230 ("when the patent expires * * * the right to make the article—including the right to make it in precisely the shape it carried when patented—passes to the public").

3. This is not to say that the right to copy encompasses incidental items that are not part of the invention itself. We agree with the Solicitor General that "where the element alleged as trade dress is only incidentally included in the patent or product, *i.e.*, where the feature is not a utilitarian part of the invention itself, there is no bar to trade dress protection." SG Br. 19-20. Thus, the purple bow shown on the patent drawing for a new type of chair (*see* Thomas & Betts Br. 23) could be protected as trade dress. It is plainly not part of the invention claimed in the patent. Because the

patentee would not be entitled by virtue of its patent to preclude competitors from placing a purple bow on their chairs for the life of the patent, the symmetry of the patent bargain does not require that the public be allowed to copy that ornamental feature once the patent expires. Extending trade dress protection to such a feature thus does not compromise the patent bargain or the constitutional mandate that patent protection be granted only for "limited Times."

Here, of course, the feature that MDI seeks to protect as trade dress is not an ornamental, incidental feature that is not part of the invention. What MDI claims as trade dress—the "dual-spring design" connecting the stand to the base, *see* Pet. Br. 7-8—*is* the invention. The springs are the feature claimed in the patent that makes the invention work—they are the reason the stands successfully resist the wind. *See* Pet. App. 18a; J.A. 220. That is what the patent discloses, and that is what MDI claimed when it prosecuted Winn-Proof for marketing a sign stand indistinguishable from the TrafFix stand at issue here. During the life of MDI's patents, MDI was entitled to—and, in the *Winn-Proof* litigation, *did* —enforce its patents to prevent a competitor from selling a dual-spring traffic sign stand that worked and looked like MDI's. Now that the patents have expired, the public is entitled to copy that same article.

MDI touted the superior performance of its "patented dual-spring mounted design" sign stand when that sign stand enjoyed patent protection, Pet. App. 55a; L88, and in the *Winn-Proof* litigation—when it suited it—MDI argued that its dual-spring design "achieved unique, beneficial, unexpected and surprising results." J.A. 195; *see id.* 224-226. If accepted, MDI's position would allow it to enjoy exclusive rights in its superior product in perpetuity, in direct contravention of the patent bargain, the express terms of the Patent Clause, and our Nation's "instinctive aversion to monopolies." *Graham* v. *John Deere Co.*, 383 U.S. 1, 7 (1966). MDI enjoyed those exclusive rights for the duration of its

patent. It must now live up to its side of the bargain and recognize that the invention is now public property.

There may, of course, be cases at the margin in which it is more difficult to determine whether a particular feature claimed as trade dress contributes to the operation of the invention claimed in the patent or instead is incidental ornamentation. But patent law has developed precise rules over the centuries to allow the public to ascertain what is claimed as an invention. MDI's approach would have patent protection turn on one set of rules, and the public's right to copy turn on another—the unwieldy and fluid "legal functionality" inquiry. The principle underlying the right to copy is clear: whatever is afforded patent protection passes to the public when the patent expires. In most cases, there will be no difficulty distinguishing between the purple bow tied to a chair and the underlying invention itself.

III. RESPONDENT'S "LEGAL FUNCTIONALITY" TEST WOULD ALL BUT ELIMINATE THE RIGHT TO COPY.

We have no quarrel with MDI's assertion that "[t]he functionality doctrine is an independent means by which trade dress protection can be denied." Resp. Br. 19. We explained in our opening brief that both Congress and this Court have invoked the concept of "functionality" to ensure that trademark law does not encroach on "the province of patent law." *Qualitex Co.* v. *Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995). *See* Pet. Br. 30-33, 38-39. But trademark law's functionality doctrine can fulfill that role only to the extent it is based on a common sense understanding of functionality, so that a product that is the subject of an expired utility patent *is*—by virtue of the same utilitarian features that entitled the product to patent protection in the first place—*functional*. *See* 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 7:89 (4th ed. 1996). The Solicitor General agrees, and has explained at length how the right to copy from expired patents comports with a

proper construction of the functionality doctrine, and why the asserted trade dress in this case is—as a matter of law—functional and thus not protected by the Lanham Act.

Respondent—relying largely if not entirely on a handful of recent lower court decisions—urges this Court to embrace the quite different concept of "legal functionality," which divorces functionality from utility and instead anchors it to "competitive need." *See* Resp. Br. 21 (distinguishing between "utility" and "legal functionality" and noting that "[t]hese two concepts are significantly different and should not be confused"); *id.* 33, 40 ("legal functionality" test asks whether "a design is necessary for effective competition"); Pet. App. 20a ("The appropriate question is whether the particular product configuration is a competitive necessity.").

MDI would define "legal functionality" and "competitive need" largely in terms of "available alternatives," and goes so far as to assert that this Court adopted "[t]he 'available alternatives test' for functionality" in *Qualitex*. Resp. Br. 20-21. The Court did not do so, and instead discussed functionality in more traditional terms, focusing on whether the feature in question was "useful." 514 U.S. at 164. As the Court explained, the purpose of the functionality doctrine is to prevent trademark law from "allowing a producer to control a useful product feature." *Id.* Certainly nothing in the Court's opinion remotely suggested that the right to copy from an expired patent should be revisited, that the right only exists when there are no "available alternatives" to the previously-patented invention, or that an elaborate factual inquiry was necessary to assess the range of such alternatives before a producer could safely exercise the right. In fact, the Court indicated just the opposite, reaffirming that "[i]t is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, * * * *after*

which competitors are free to use the innovation." *Id.* (emphasis added). *See* Pet. Br. 39-40; SG Br. 25-26.[7]

Under MDI's approach, what began as "a federal right to 'copy and to use,' " *Bonito Boats*, 489 U.S. at 165, becomes at the end of the day "at best, only one factor in a functionality analysis." Resp. Br. 21. *See also id.* 8 ("The existence of MDI's expired patents is irrelevant in this case"); *id.* 33 ("the existence of a patent has little, if any, relevance to the trade dress inquiry"). This dismissive approach to the right to copy from an expired patent replicates the position of the lower court that "troubled" and "puzzl[ed]" this Court in *Bonito Boats*, and compelled this Court to emphasize that a century of precedent "established that in the case of an expired patent, the federal patent laws *do* create a federal right to 'copy and to use.' " 489 U.S. at 164-165 (emphasis in original). MDI acknowledges that its "legal functionality" approach would eliminate that right "[i]n most cases." Resp. Br. 33.

That would certainly follow as a matter of practical application, if nothing else. Given the imprecision of the multi-factor "legal functionality" standard, no would-be competitor could ever have any confidence that it could exercise the right to copy from an expired patent, without incurring the very real risk of years of expensive litigation with an unpredictable outcome. *See* Pet. Br. 40-43; SG Br. 20-22. Such a result carries tangible costs, because "imitation and refinement through imitation" is "the very lifeblood

---

[7] MDI's suggestion that Congress has also "endorsed" the " 'available alternatives test' for functionality" is just as fanciful. MDI cites a single sentence from a House Report as its sole support for this assertion. *See* Resp. Br. 20 n.16. The sentence is merely descriptive and can hardly bear the weight of establishing that Congress meant to override the right to copy that was an established feature of patent and unfair competition law when Congress enacted the Lanham Act. *See* SG Br. 24 n.11.

of a competitive economy." *Bonito Boats*, 489 U.S. at 146. *See* Pet. Br. 42-43. That was shown in this case, where TrafFix did not simply copy MDI's sign stand but improved upon it with patented refinements of its own. J.A. 253.

Our approach and that of the Solicitor General, in contrast —while not "absolute" along the lines of the straw man MDI attacks—does have the benefit of being "per se" in the following sense: when, as here, a device has clearly enjoyed utility patent protection, the public is entitled to copy and use the device when the patent protection expires—without regard to any asserted "trade dress" in the invention itself. That rule gives effect to the right to copy that this Court has repeatedly recognized and reaffirmed over the past century; it is grounded in our Nation's Constitution and history; and it gives effect to the patent bargain that has always underlay our patent system. It also squares with Congress's intent in enacting and amending the Lanham Act.

IV. THERE IS NO BASIS IN THE LANHAM ACT TO SUBORDINATE THE RIGHT TO COPY TO "LEGAL FUNCTIONALITY."

MDI makes a great deal out of how unfair competition laws and patent laws "have coexisted for centuries without conflict." Resp. Br. 8; *see id.* 10-12. But of course—in *Singer*, *Kellogg*, *Scott Paper*, *Sears*, *Compco*, and other cases —this Court held that unfair competition law had to give way to the public's right to copy. Those decisions are important and controlling in their own right, particularly given their reaffirmation in *Bonito Boats*. But they are also significant in construing the scope of the Lanham Act. As we have explained (Pet. Br. 28-29), every indication is that Congress sought to codify the understanding reflected in cases such as

Singer, *Kellogg*, and *Scott Paper* when it enacted the Lanham Act. *See also* SG Br. 16-19 & n.7.[8]

MDI and its amici have little or nothing to say in response to our argument that Congress did not intend for the Lanham Act to confer trade dress protection on products that are the subject of expired utility patents. In interpreting the Lanham Act, MDI and its amici would give absolutely no weight to the fact that when it was enacted, and until the recent phenomenon of "product configuration trade dress," it was understood as a result of this Court's decisions and the patent laws and policies that the public enjoys the right to copy from expired patents. The Lanham Act and patent laws existed harmoniously until courts expanded the concept of trade dress beyond product packaging or dressing to the product itself.

It is that concept of "product configuration trade dress" that has forced the issue in this case, and threatens to disrupt the manner in which patent law and unfair competition law have coexisted for centuries. To accommodate this new and expansive notion, MDI asks this Court to effect a dramatic shift in patent law and unfair competition law (as now codified in the Lanham Act), extending unfair competition law into a realm that historically has been kept off limits by

---

[8] The Solicitor General proposes that Congress expected the result in *Singer* and its progeny to be preserved through the functionality doctrine, and that any approach to functionality that effectively overturns *Singer* and its progeny cannot be reconciled with Congress's intent or the rules of statutory construction. *See* SG Br. 22-24. We agree, but also believe that the Lanham Act left *Singer* and its progeny intact as a matter of substantive patent law. Under either approach, however, the result is the same: whatever is afforded protection under the patent passes, as a matter of substantive patent law, to the public when the patent expires. And exclusive rights thereto cannot be resuscitated under the Lanham Act, just as they could not under the unfair competition and trademark law the Lanham Act codified.

this Court. But the growth of the concept of product configuration trade dress has largely been the work of some lower federal courts over the past two decades—not Congress. This Court should not alter the balance carefully struck in a line of cases running from *Singer* through *Kellogg*, *Scott Paper*, *Sears*, *Compco*, and *Bonito Boats* without any indication from *Congress* that it intends such a wholesale restructuring in the name of promoting product configuration trade dress—even at the expense of basic principles underlying the patent bargain.

V. MDI'S PARADE OF HORRIBLES IS NOT SO FRIGHTENING.

MDI conjures up a parade of horribles that it contends would flow from recognizing the right to copy from an expired patent. The fact that the right has been recognized for over a century without the dire consequences predicted by MDI detracts considerably from the force of its argument.

1. MDI's suggestion that acceptance of TrafFix's position would cause manufacturers to forego patent protection—and the beneficial public disclosure patent law requires—in favor of securing trade dress rights, Resp. Br. 38, cannot be taken seriously. In the first place, it is difficult to imagine a manufacturer willing to give up the legal right to exclude all other competitors for 20 years to pursue the hope that it could develop sufficient secondary meaning in a configuration to mount an uncertain trade dress claim before other competitors step in with copies of the purported invention. Second, the functionality doctrine still applies to trade dress claims, and would certainly compromise efforts to secure such protection for a product configuration that would also qualify for patent protection.

2. Nor is MDI correct that such distinctive shapes as the Coke bottle or the Volkswagen "Beetle" would suddenly lose their eligibility for trade dress protection if this Court were to reaffirm its holdings in *Singer*, *Kellogg*, and *Bonito Boats*.

Resp. Br. 38-39. MDI's argument is *not* that these features are covered by a patent or have enjoyed patent protection, and are therefore ineligible for further protection under the guise of trade dress under our theory. It is instead that these features appear incidentally in patents claiming as an invention some method or other feature. Thus, the Coke bottle appears in a patent for a method of affixing a label, and the Beetle in a patent for a dashboard grille. Resp. Lodging 5, 6. As we have explained, because such incidental appearance does not entitle the Coke bottle or Beetle to patent protection during the life of the patent, it also does not confer on the public a right to copy when the patent expires. *See supra* at 4, 9-11.

3. MDI's contention that our position "would turn trade dress cases into patent cases requiring claim interpretation as a prerequisite in determining the availability of trade dress protection," including "at least * * * a *Markman*-type hearing," Resp. Br. 1, 36, is wrong. This case proves it. No "*Markman*-type hearing" is necessary here to reject MDI's trade dress claim, when MDI itself asserted that what it now seeks to protect as trade dress was covered by its patents—both through labeling, *see*, *e.g.*, L88-L89, and litigation, *see Sarkisian* v. *Winn-Proof Corp.*, *supra*. Such consideration of the conduct of the entity seeking trade dress protection—not a *Markman*-type hearing—should typically suffice to decide most cases.

4. MDI takes a Socratic approach at the end of its brief, but its contention that reaffirming the century-old public right to copy would raise "several significant issues" is just a last-ditch effort to kick up dust.[9] None of the questions MDI

---

[9] Briefly, the answers to MDI's queries (Resp. Br. 40-41): (1) If the producer could have gone into court armed with its patents and prevented a competitor from selling the asserted "product configuration" trade dress during the life of the patents, then the right to copy attaches to that product configuration when the patents

poses is remotely presented by this case. A more fundamental one is: if the right to copy the subject of an expired patent is not triggered in this case—when the patent holder explicitly claimed that the feature to be copied was covered by its patents and successfully sued to enjoin copying of the feature during the life of the patent—when would the right ever be found to exist? And if the answer to that question depends upon the application of a fact-intensive, multi-factor "legal functionality" test, what then is left of the right?

* * *

The dual-spring traffic sign stands at issue in this case—which appear along highways across America—are scarcely the sort of "trade dress" that typically comes to mind. While the stands take a particular form, their form is a product of their intended function, especially when it comes to the key dual-spring base. All agree that MDI's invention achieves dramatic results in staying upright in extreme conditions. MDI had a 17-year monopoly on that invention and used it to

---

expire; (2) These facts do not make a difference. No one can secure trade dress protection for that which was protected by a patent because the right to copy is a public right; (3) The same standards used in determining whether a product is entitled to patent protection in the first place; (4) The policy may apply more broadly, but is clearly and directly implicated here because of the patent bargain; (5) In the absence of a patent a configuration will usually be copied before it acquires secondary meaning. But the answer is yes, because of the patent bargain. As for improvements, *see* SG Br. 20 n.8; (6) Competitors can seek to patent items that others might claim as trade dress, but they probably would not succeed in obtaining the patents; and (7) Design patents may present a different case, because they do not protect utilitarian products or features but rather ornamental designs. At the same time, it seems perfectly reasonable to apply the patent bargain and require a designer to forego future trade dress protection in exchange for the benefits of immediate, 20-year patent protection.

great commercial effect; now that its patents have expired, the public should be free to copy and use MDI's invention and, as TrafFix did, improve on it. That is the familiar cycle of innovation, imitation, and refinement through imitation that our Nation's Constitution and laws have always permitted and, indeed, promoted.

CONCLUSION

For the foregoing reasons, and those in petitioner's opening brief, the judgment below should be reversed.

Respectfully submitted,

JEANNE-MARIE MARSHALL
RICHARD W. HOFFMANN
REISING, ETHINGTON, BARNES, KISSELLE, LEARMAN & MCCULLOCH, P.C.
201 W. Big Beaver—Suite 400
Troy, Michigan 48084
(248) 689-3500

JOHN G. ROBERTS, JR.*
H. CHRISTOPHER BARTOLOMUCCI
HOGAN & HARTSON L.L.P.
555 Thirteenth Street, N.W.
Washington, D.C. 20004
(202) 637-5810

* Counsel of Record

Counsel for Petitioner